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09/616,977	07/14/2000	Aviad Zlotnick	6727/OH417	7345

7590  
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805 Third Avenue  
New York, NY 10022

02/24/2006

EXAMINER
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STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/616,977

Applicant(s)

ZLOTNICK, AVIAD

Examiner

Kyle R. Stork

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4-19 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-19, and 22-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This final office action is in response to the Remarks and Declaration under 37 C.F.R. 1.131 filed 7 December 2005.
2. Claims 1, 4-19, and 22-37 are pending. Claims 1, 12, 19, 30, 35, and 37 are independent claims.

### *Oath/Declaration*

3. The declaration filed on 7 December 2005 under 37 CFR 1.131 has been considered, but is ineffective to overcome the Bruce reference.

Applicant attempts to establish a prior invention by showing a conception prior to March 24, 2000, the effective date of the Bruce reference, coupled with diligence from just prior to that date until the filing of this application on 14 July, 2000.

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131. (MPEP 715.07)

The affidavit or declaration and exhibits ***must clearly explain*** which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. ***Vague and general statements*** in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice ***"amounts essentially to mere pleading***, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In *re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07) [Emphasis added]

#### ***a. Conception***

Applicant relies upon the invention disclosure document to establish conception. The statement in the affidavit to support conception is " Prior to March 24, 2000, I conceived

my invention, as described and claimed in the subject application, in Israel, a WTO country. Conception of the invention is evidenced by an IBM Disclosure that I wrote, entitled "Internet Directory Service For Forms Processing" (serial no. 94850-1), which is attached hereto as Appendix A." The applicant has further provided a table attempting to map the claim limitations to Appendix A (pages 2-3)

4. However, not all limitations of the claims are disclosed in Appendix A. The applicant claims that "each form including a field that is filled in with information in a predefined domain (page 2, top left cell)." However, the applicant relies upon a section of Appendix A directed toward a directories, not domains. The disclosure specifically discloses directories containing information, such as telephone directories and a directory of medical practice offices (page 1, second paragraph). Further, the applicant claims, "receiving from a client via a computer network the information that is filled into the field on the forms by a plurality of users in communication with the client (page 3, top left cell)." However, the disclosure fails to mention information filled into the field on a form by a plurality of users in communication with the client. Instead, it simply relies on a directory service provider providing a form filled with form data to a software integrator (page 2, first full paragraph).

5. Therefore, Applicant has not met her burden of showing prior conception of the claimed invention.

### ***b. Diligence***

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather applicant must show evidence or facts establishing diligence (MPEP 715.07(a)).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6<sup>th</sup> Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of

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diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The 'lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon' is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). (MPEP 715.07(a)).

6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Bruce reference to either a constructive reduction to practice or an actual reduction to practice. The applicant has merely relied upon the assertions that:

"5) On March 14, 2000, I met with Dr. Daniel Kligler, of Sanford T. Colb & Co., who was retained by IBM as outside counsel for the purpose of preparing the present patent application. I was informed that Dr. Kligler had a substantial backlog of new applications that he was preparing for IBM, and that there would consequently be a delay of approximately two months in drafting this application.

6) On May 30, 2000, Dr. Kligler sent me a first draft of the patent application. I responded immediately with comments and corrections to the draft.

7) On June 1, 2000, Dr. Kligler sent me a revised draft of the patent application.

8) I immediately approved the revised draft for filing. It was then sent to an IBM in-house attorney for review. The attorney gave final approval to file the application on June 20, 2000. After I executed the filing documents, the application was then sent to the United States, where it was filed on July 14, 2000."

7. This assertion fails to demonstrate "evidence or facts establishing diligence" for the "lapse of time between the completion or reduction of practice of an invention and the filing of an application thereon (MPEP 715.07(a))." Applicant has failed to demonstrate evidence or facts to show diligence from the date of the reference or activity through the date of a reduction to practice as required by the MPEP 715.07(a). While the applicant has provided dates, no specific evidence has been submitted to establish diligence. Diligence requires that applicants be specific as to both dates and facts.

8. For at least the reasons cited above the affidavit is ineffective to establish conception prior to 24 March 2000. Therefore the Bruce rejection is maintained.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 5-11, 19, 23-29, and 35-36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lorie (US 5933531, patented 3 August 1999) and further in view of Jansen et al. (US 6243450, filed 28 December 1998, hereafter Jansen).

As per independent claim 1, Lorie discloses a method for processing document including information in a predefined domain, the method comprising:

- Defining a directory of data relating to the predefined domain (column 1, line 64- column 2, line 9; column 5, lines 9-12)
- Receiving from a client via a computer network images of a number of fields containing respective information (column 1, lines 16-30; column 8, lines 50-67)
- Processing the images to code the information (column 1, lines 31-36)
- Looking up the coded information in the directory so as to check whether the information is coded correctly (column 1, line 64- column 2, line 9)
- Returning the checked coded information (Figure 1)

Lorie fails to specifically disclose receiving payment for a service based upon a price per unit of service. However, Jansen discloses receiving payment for a service based upon a price per unit of service (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lorie's method with Jansen's method, since it would have allowed a user to receive payment for the use of service over the internet (Jansen: column 2, lines 9-11).

As per dependent claim 5, Lorie and Jansen disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Lorie further discloses the method wherein receiving the images comprises receiving images of alphanumeric characters in the fields (column 1, lines 21-36).

As per dependent claim 6, Lorie and Jensen disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lorie further discloses the method wherein the documents include a template delineating the fields, and wherein receiving the images of the characters comprises receiving the images of the characters filled into the fields and remaining after drop-out of the template from the image of the fields (column 1, lines 16-30).

As per dependent claim 7, Lorie and Jansen disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lorie further discloses the method wherein processing the images comprises applying computerized optical character recognition (OCR) to code the characters (column 1, lines 31-36).

As per dependent claim 8, Lorie and Jensen disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Lorie further discloses the method wherein looking up the coded information comprises selecting a preferred reading of the characters from among two or more possible readings generated by the OCR, responsive to the data in the directory (column 4, lines 19-32).

As per dependent claim 9, Lorie and Jensen discloses the limitations similar to those in claim 7, and the same rejection is incorporated herein. Lorie further discloses the method wherein looking up the coded information comprises generating a confidence score, and wherein processing the images comprises passing the images to a human operator for coding when the confidence score is below a predetermined threshold (column 5, lines 1-54).

As per dependent claim 10, Lorie and Jensen disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Lorie further discloses the method wherein looking up the coded information comprises detecting an error in the coded characters and correcting the error using the data in the directory (column 4, lines 19-32: Here, the context analyzer attempts to correct errors based upon the context of the data).

As per dependent claim 11, the applicant discloses the limitations similar to those in claim 10. Claim 11 is similarly rejected.

As per independent claim 19, the applicant discloses the limitations similar to those in claim 1. Claim 19 is similarly rejected.



As per dependent claim 23, the applicant discloses the limitations similar to those in claim 5. Claim 23 is similarly rejected.

As per dependent claim 24, the applicant discloses the limitations similar to those in claim 6. Claim 24 is similarly rejected.

As per dependent claim 25, the applicant discloses the limitations similar to those in claim 7. Claim 25 is similarly rejected.

As per dependent claim 26, the applicant discloses the limitations similar to those in claim 8. Claim 26 is similarly rejected.

As per dependent claim 27, the applicant discloses the limitations similar to those in claim 9. Claim 27 is similarly rejected.

As per dependent claim 28, the applicant discloses the limitations similar to those in claim 10. Claim 28 is similarly rejected.

As per dependent claim 29, the applicant discloses the limitations similar to those in claim 11. Claim 29 is similarly rejected.

As per independent claim 35, the applicant discloses the limitations similar to those in claim 1. Claim 35 is similarly rejected.

As per dependent claim 36, the applicant discloses the limitations similar to those in claim 7. Claim 36 is similarly rejected.

11. Claims 4 and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lorie and Jensen and further in view of Bruce et al. (US 6741724, filed 24 March 2000, hereafter Bruce).

As per dependent claim 4, Lorie and Jensen disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Lorie fails to specifically disclose defining the directory comprises selecting data specific to the predefined domain from one or more general databases. However, Bruce discloses defining the directory comprises selecting data specific to the predefined domain from one or more general databases (column 2, lines 34-67).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lorie and Jensen's method with Bruce's method, since it would have allowed a user to validate scanned data against accepted data (column 2, lines 57-60).

As per dependent claim 22, the applicant discloses limitations similar to those in claim 1. Claim 22 is similarly rejected.

12. Claims 12-16, 18, 30-34, and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lorie and further in view of Bruce.

As per independent claim 12, Lorie discloses a method for processing forms, each form including a field that is filled in with information in a predefined domain, the method comprising:

- Defining, in advance of reading out contents of the forms for processing, a directory of data relating to the predefined domain (column 1, line 64- column 2, line 9; column 5, lines 9-12)

- Receiving from a client via a computer network the information that is filled into the field on the forms by a plurality of users in communication with the client (column 1, lines 16-30; column 8, lines 50-67)
- Checking whether the information is correct by looking up the information in the directory (column 1, line 64- column 2, line 9)

Lorie fails to specifically disclose defining the directory comprises selecting data specific to the predefined domain from one or more general databases. However, Bruce discloses defining the directory comprises selecting data specific to the predefined domain from one or more general databases (column 2, lines 34-67).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lorie and Jensen's method with Bruce's method, since it would have allowed a user to validate scanned data against accepted data (column 2, lines 57-60).

As per dependent claim 13, the applicant discloses limitations similar to those disclosed by Lorie with respect to claim 1. Claim 13 is similarly rejected.

As per dependent claim 14, the applicant discloses the limitations similar to those disclosed by Lorie with respect to claim 7. Claim 14 is similarly rejected.

As per dependent claim 15 the applicant discloses limitations similar to those disclosed by Lorie with respect to claim 1. Claim 15 is similarly rejected.

As per dependent claim 16 the applicant discloses limitations similar to those disclosed by Lorie with respect to claim 1. Claim 16 is similarly rejected.

As per dependent claim 18, the applicant discloses limitations similar to those disclosed by Lorie with respect to claim 10. Claim 18 is similarly rejected.

As per independent claim 30, the applicant discloses limitations similar to those in claim 12. Claim 30 is similarly rejected.

As per dependent claim 31, the applicant discloses limitations similar to those in claim 13. Claim 31 is similarly rejected.

As per dependent claim 32, the applicant discloses limitations similar to those in claim 15. Claim 32 is similarly rejected.

As per dependent claim 33, the applicant discloses limitations similar to those in claim 16. Claim 33 is similarly rejected.

As per dependent claim 34, the applicant discloses limitations similar to those in claim 18. Claim 34 is similarly rejected.

As per independent claim 37, the applicant discloses limitations similar to those in claim 12. Claim 37 is similarly rejected.

13. Claims 17 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Lorie and Bruce and further in view of Jensen.

As per dependent claim 17, Lorie and Bruce disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Lorie fails to specifically disclose receiving payment for a service based upon a price per unit of service.

However, Jansen discloses receiving payment for a service based upon a price per unit of service (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lorie and Bruce's method with Jansen's method, since it would have allowed a user to receive payment for the use of service over the internet (Jansen: column 2, lines 9-11).

### ***Response to Arguments***

14. Applicant's arguments filed 7 December 2005 have been fully considered but they are not persuasive.

As per claim 1, the applicant argues that Lorie is simply a stand alone computer, and fails to mention or suggest sending data over a network (page 2, first full paragraph). However, the examiner respectfully disagrees. Lorie discloses executing the method in a network environment, containing clients and servers (column 8, line 50-column 9, line 31).

The applicant further argues that Jansen fails to teach or suggest the notion of charging for processing fields containing information on the basis of a price per field. The examiner respectfully disagrees. Jansen, as the applicant acknowledges, teaches charging based upon a price per unit of service (abstract). A field is a well known unit. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Jansen with Lorie, since it would have allowed a user to receive payment for the use of service over the internet (Jansen: column 2, lines 9-11).

With respect to the Bruce reference, the applicant attempts to establish conception of the invention prior to the effective date of the Bruce reference. However,

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as disclosed above, the applicant has not sufficiently proved conception. This argument is therefore not persuasive.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

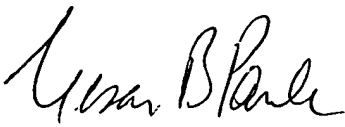
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork  
Patent Examiner  
Art Unit 2178

krS

  
**CESAR PAULA**  
**PRIMARY EXAMINER**